

### REMARKS

This responds to the Office Action mailed on September 7, 2005, and the references cited therewith.

Claims 17-20, 26, 28, 33-34, and 38 are amended, no claims are added or canceled; claims 17-40 are now pending in this application.

### Claim Objections

Claims 33 and 34 were objected to for incorrect dependencies. Claims 33 and 34 have been amended as required.

### §112 Rejection of the Claims

Claims 17-25, 28, 30-31 and 38-39 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The claims have been amended to correct for any antecedent issues. Reconsideration and allowance of claims 17 – 25, 28, 30-31, and 38 – 39 are respectfully requested.

### §102 Rejection of the Claims

Claims 17-18, and 26 were rejected under 35 U.S.C. § 102(e) for anticipation by Heck (US 6,083,207). Applicant respectfully traverses the rejection. “For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” (emphasis added). *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant cannot find in the cited reference a releasable side port assembly coupled with a side member, where the side member is coupled along the sheath, as recited in claim 17. Claim 18 contains additional limitations to claim 17. Furthermore, Applicant cannot find in the cited reference a side port coupling member releasably coupled along a sheath hub. Reconsideration and allowance of claims 17-18 and 26 are respectfully requested.

§103 Rejection of the Claims

Claims 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarfone et al. (US 5,300,046) in view of West et al. (US 6,322,541). Claims 38-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarfone et al. ('046) in view of West ('541) (as applied to claim 37 above), and further in view of Trinder (US 2,493,326). Claim 40 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarfone et al. ('046) in view of West (as applied to claim 35 above), and further in view of Dressel (US 5,102,410). The cited references fail to establish all of the elements of claims 35 - 40. For instance, Applicant cannot find in Scarfone, West, Trinder, or Dressel, or in combination thereof, the method of uncoupling a side port assembly from a coupled position, as recited in claim 35, from which claims 36 - 40 depend. Furthermore, Applicant cannot find in the cited references, sealing the side port of the introducer with the side port valve after removing the side port assembly, as recited in claim 35, from which claims 36-40 depend.

Notwithstanding the fact that all elements cannot be found in the cited references, Applicant further traverses the rejection because the cited references are not enabling. The cited references fail to enable a releasable side port that is releasably coupled with the sheath. Furthermore, the Office Action fails to provide an objective motivation to combine the references. Notwithstanding that the references fail to establish all of the elements of the claims as discussed above, Applicant submits the Office Action fails to establish a *prima facie* of obviousness, because there is no *objective* motivation to combine the references. According to the Office Action "it would have been obvious . . . since the use thereof would provide an improved fluid flowing control method, in an introducer application," or "it would have been obvious . . . since the use thereof would provide an improved method to prevent fluid leak from an introducer." Office Action, Page 6.

As the Federal Circuit has stated: "Virtually all inventions are combinations of old elements. . . . If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal*

*Inc.*, 56 U.S.P.Q.2d 1641, 1644 (Fed. Cir. 2000), quoting *In re Rouffet*, 149 F.3d 1350, 1357-1358, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998).

Instead, motivation to combine the references must be found in the prior art, and not based on Applicant's disclosure. Furthermore, a showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.2d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

Applicant notes that no objective support is provided for any of these assertions and instead the Office Action uses the claims as a template and selectively uses elements from various references, declaring it an "improvement". While Applicant agrees that the claims involve an improvement over the art, the Office Action fails to establish a legally sufficient nor objective motivation to so selectively combine the references. In fact, it appears the Office Action is relying on the personal knowledge of the Examiner. Applicant requests an affidavit supporting the assertions as required by 37 CFR 1.104(d)(2). Applicant further traverses the assertion under MPEP 2144.03 or removal of the unsupported assertion and removal of the rejection. Reconsideration and allowance of the claims are respectfully requested,

Claims 17-22, 25, 26-29, 33, and 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (US 5,755,693) in view of Scarfone et al. ('046), and further in view of West et al. ('541). Claims 23-24, 30-31 and 38-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. ('693) in view of Scarfone et al. ('046), and further in view of West et al. (as applied to claims 22, 26 and 35), and further in view of Trinder '326). Claims 32, 24 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. ('693) in view of Scarfone et al. ('046), and further in view of West et al. (as applied to claims 26 and 35), and further in view of Trinder '326).

Applicant respectfully traverses the rejection because all of the elements cannot be found in the cited references. For instance, Applicant cannot find in Walker, Scarfone, or West, or in combination thereof, a releasable side port assembly including one or more features allowing for the releasable side port assembly to be released without damage, as recited in claim 17, from which claims 18-25 depend. Furthermore, Applicant cannot find in the cited references, a side

port assembly having a coupled and uncoupled position, as recited in claim 26, from which claims 27–33 depend. Still further, Applicant cannot find in the cited references the method of uncoupling a side port assembly from a coupled position, as recited in claim 35, from which claims 36–40 depend. Furthermore, Applicant cannot find in the cited references, sealing the side port of the introducer with the side port valve after removing the side port assembly, as recited in claim 35, from which claims 36–40 depend.

Notwithstanding the fact that all elements cannot be found in the cited references, Applicant further traverses the rejection because the cited references are not enabling. The cited references fail to enable a releasable side port that is releasably coupled with the sheath. The references are silent as to this issue.

Furthermore, the Office Action fails to provide an objective motivation to combine the references. Notwithstanding that the references fail to establish all of the elements of the claims as discussed above, Applicant submits the Office Action fails to establish a *prima facie* of obviousness, because there is no *objective* motivation to combine the references. According to the Office Action “it would have been obvious . . . since the use thereof would provide an improved sheath introducer” or “an improved introducer and method of using it.” Office Action, Pages 7–8. Still further, the Office Action states “it would have been obvious . . . since the use thereof would provide an improved introducer and method, with a better control on the fluid flowing through,” or “the use thereof would provide an improved method to prevent fluid [sic] leak from an introducer.” Office Action, Pages 8 – 9.

Applicant notes that no objective support, for example *any* support from the cited references, is provided for any of these assertions and instead the Office Action uses the claims as a template and selectively uses elements from various references, declaring it an “improvement”. While Applicant agrees that the claims involve an improvement over the art, the Office Action fails to establish a legally sufficient or objective motivation to so selectively combine the references. In fact, it appears the Office Action is relying on the personal knowledge of the Examiner. Applicant requests an affidavit supporting the assertions as required by 37 CFR 1.104(d)(2). Applicant further traverses the assertion under MPEP 2144.03 or removal of the unsupported assertion and removal of the rejection. Reconsideration and allowance of the claims are respectfully requested.

Reservation of Right to Swear Behind References

Applicant reserves the right to swear behind any references which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3276 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MICHAEL LANGE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 359-3276

Date Feb 21, 2006

By 

Catherine I. Klima-Silberg  
Reg. No. 40,052

CERTIFICATE UNDER 37 CFR 1.8: Date of Deposit: February 22, 2006

This paper or fee is being filed on the date indicated above using the USPTO's electronic filing system EFS-Web, and is addressed to: The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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